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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/468,496	12/21/1999	RON WAKSMAN M. D.	WELD-111-DIV	3711
7590	12/02/2003			
STEPHEN B. HELLER COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER, LTD. 200 WEST ADAMS STREET - SUITE 2850 CHICAGO, IL 60606			EXAMINER DESANTO, MATTHEW F	
			ART UNIT	PAPER NUMBER
			3763	

DATE MAILED: 12/02/2003

14p

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/468,496

Applicant(s)

WAKSMAN M. D. ET AL.

Examiner

Matthew F DeSanto

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-35, 37 and 41-49 is/are pending in the application.
- 4a) Of the above claim(s) 41, 45, 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-35, 37, 42-44 and 47-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 41, 45, and 46 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are drawn to a non-elected species. The claims are not drawn to Figures 7A & 7B as elected by the applicant in Paper number 6.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 41, 45 and 46 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 33, 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 33 and 34 recite the limitation "the treating element." There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 3763

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 29-34, 35, 37, 42, 43, 44, 47, 48, and 49 are rejected under 35

U.S.C. 102(b) as being anticipated by Nita (USPN 5267954). Nita discloses a catheter comprising, a first tube having a lumen closed at its distal end and sized to receive the treating element, a second tube in parallel relation to the first tube and having a lumen open at its distal end and sized to receive a guidewire, and a third tube for receiving first and second tube and having a fluid return lumen in fluid communication with the lumen of the first elongated tube.

Where the distal end of the third tube extends beyond the distal ends of the first and second tubes. Wherein the distal end of the second tube is coterminous with the distal end of the third tube, both which extend beyond the distal end of the first tube. Wherein the lumen of the first tube has an inside diameter less than twice the outside diameter of the treating element. Wherein the first tube includes an internal barrier to block the passage of the treating element out of the first tube, and where the internal barrier has an aperture. (Figures 6, 6b, 10 and entire reference).

8. Claim 44 is rejected under 35 U.S.C. 102(e) as being anticipated by Yock (USPN 5501227). Yock discloses a catheter comprising, a first tube having a lumen closed at its distal end and sized to receive the treating element, a second tube in parallel relation

Art Unit: 3763

to the first tube and having a lumen open at its distal end and sized to receive a guidewire, and a third tube for receiving first and second tube and having a fluid return lumen in fluid communication with the lumen of the first elongated tube. (Figures 6B, and 7B, column 5, lines 49-67, and entire reference).

Response to Arguments

5. Applicant's arguments filed 9/23/03 have been fully considered but they are not persuasive.

6. The applicant argues with regards to Nita, that there is no fluid return lumen between the first and second tube, and that the space does not have opening to the outside said catheter at the distal end thereof and finally that the tubes does not extend substantially the length of the catheter. The examiner disagrees with all of these statements, and directs the applicant to Figures 6, and 6b, wherein the return lumen is reference number 22. The first tube is reference number 24, which allows the treating element to be received within the tube (ultrasonic waves), the second tube is reference number 156, and the third tube is reference number 20 and 26. The openings or apertures are not at the distal end of the third tube but instead in the middle of the catheter and therefore the examiner still holds his rejection.

7. The 102 Rejection drawn to Weaver et al. is withdrawn.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

Art Unit: 3763

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 29--34, 35, 37, 42, 43, 44, 47, 48, and 49 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 6, 7, 8, 10, 11, 12, 17, 19, 20, 22, 35, of U. S. Patent No. 5,899,882 and with claims 1, 4, 5 of U.S. Patent No. 5,683,345. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent and the application are claiming common subject matter, as follows: a first, second and third tube with a treating element placed in one of the tubes.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew F DeSanto whose telephone number is 1-703-305-3292. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 1-703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 1-703-872-9306.



Matthew DeSanto
Art Unit 3763
December 1, 2003



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